

REMARKS

Summary

Claims 1-5 were pending and all of the claims were rejected in the Office Action. The specification has been amended to add a priority claim which has been previously asserted and acknowledged. No new matter has been added. The Applicants have carefully considered the references and the reasons for rejection advanced by the Examiner and respectfully traverse the rejections in view of the discussion presented below.

Claim Rejections

35 U.S.C §103 (a)

Claims 1-2, and 5 were rejected under 35 U.S.C. §103 (a) as being unpatentable over Nantz et al. (US 6,647,773; "Nantz"), in view of Lin (US 6,259,362; "Lin"). The Applicants respectfully traverse the rejection on the basis that a *prima facie* case of obviousness has not been made out.

Claim 1 recites, *inter alia*, that the vehicle-installed device comprises a recording section for recording data of any abnormality in the air pressure of the tire, and the portable device indicates a warning of an abnormal air pressure of the tire by the tire air pressure abnormality signal that the portable device has received.

The Examiner has asserted that Nantz teaches that "the vehicle-installed device comprises a recording section for recording data of any abnormality in the air pressure of the tire (see at least columns 2-3, line 29-8; and columns 4-5, lines 65-12" (Office Action page 2). The Applicants respectfully submit that the citation asserted by the Examiner teaches a controller (26) which takes the form of an appropriately programmed microprocessor or DSP (Nantz, col 5, lines 6-8) and not "a recording section for recording data of any abnormality" as recited in the arrangement of Claim 1. Further, the Examiner accepts that Nantz does not teach "the portable device comprises a warning" (Id., page 3), and asserts that this deficiency in the teaching of Nantz is remedied by Lin. However, the Examiner does not advance any reasons why the combination of the two teachings would be obvious to a person skilled in the art at the time the invention was made. The Applicants respectfully submit that the Examiner has

improperly used hindsight to read the teachings of the present Claim 1 into the references. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."

As the combination of references does not teach all of the elements of Claim 1, nor is there a reason to combine the references, the Applicants respectfully submit that the Examiner has not made out a *prima facie* case of obviousness, and Claim 1 is allowable. Claims 2, 3 and 4 are claims dependent on an allowable claim and are allowable, without more. Claim 5 is a method claim having similar elements and limitations to that of Claim 1, and the Applicants respectfully submit that it is allowable for the same reasons.

Claims 3-4 were rejected under 35 U.S.C. §103 (a) as being unpatentable over Nantz and Lin, and further in view of Pacsai (US 6,438,467; "Pacsai"). Claim 3 is independently patentable. The Applicants respectfully submit that a *prima facie* case of obviousness has not been made out. The Examiner accepts that neither Nantz nor Lin disclose the "request signal and the tire air pressure abnormality signal are transmitted by operating a door touch switch (see at least columns 4-5, lines 57-25)", (Office Action, page 4) and relies on Pacsai to remedy this deficiency. In the passage of Pacsai cited, the manually operated pushbutton switches 114 and 116 are located on the portable unit 44. This is entirely different from the arrangement of Claim 3 in which, *inter alia*, a door of the vehicle comprises a door touch switch and the tire pressure abnormality signal is transmitted by actuating the door touch switch. Therefore, not all of the elements of Claim 3 are taught by the combination of the references, nor has the Examiner set forth a reason that it would have been obvious to combine the references, and a *prima facie* case of obviousness has not been made out. For at least these reasons, Claim 3 is patentable and Claim 4, being dependent thereon is allowable, without more.

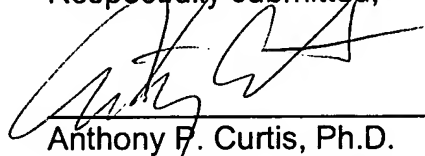
Conclusion

Claims 1-5 remain pending.

For at least the reasons given above, the Applicants respectfully submit that the pending claims are allowable.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



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